

### **REMARKS**

Applicants traverse the rejections in the pending Final Office Action and request entry of the above proposed claim amendments for simplification of issues for appeal. Specifically, Applicants propose amending claims 47 and 61-63 and cancelling claims 27-31, 39, 42, 43, 50, 52-54, 56, and 58-60. Applicants propose amending claim 47 to improve form. Applicants propose amending previously independent claims 61-63 to depend from claims 23 and 47.

In addition, Applicants submit the enclosed AFFIDAVIT OF JOHN ANTHONY UNDER 37 C.F.R. 1.132 (the "Affidavit"). According to 37 C.F.R. 1.116(e) Affidavits submitted after final shall be "admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented." The Affidavit addresses the appropriate interpretation of two references (Farmer and German) which were cited in combination with each other for the first time in the pending Final Office Action. As the rejection was new to the Final Office Action, Applicants could not have submitted evidence with respect to this combination at an earlier time.

In the Affidavit, John J. Anthony attests that, and explains why, one of ordinary skill in the art at the time of the application's filing would not have known, based on the disclosure of Farmer, how the underwriting process described in Farmer could be adapted for use in altering insurance premiums for buildings without undue experimentation. The Affidavit further states that German fails to describe or suggest that one should or how one might use data collected from monitoring technology incorporated into buildings for altering the insurance premium for an insurance policy covering the building.

The subject matter referred to above and in the Affidavit is recited in each pending independent claim. In order to render an invention unpatentable for obviousness, the prior art must enable a person of ordinary skill to make and use the invention (see *In re Kumar* 418 F.3d 1361 (Fed. Cir. 2005; see also *Beckman Instruments* 892 F.2d, 1547, 1551 (Fed. Cir. 1989)). Thus, since

the cited prior art fails to enable one of ordinary skill in the art to make and use this cited subject, and in light of the reasons set forth in Applicants' July 14, 2008 Response (incorporated herein by reference), Applicants request reconsideration and withdrawal of the independent claims 23, 44, and 47 are patentable over the cited prior art.

Accordingly, Applicants believe the application is in condition for allowance.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. HSDO-P01-003 from which the undersigned is authorized to draw.

Dated: January 23, 2009

Respectfully submitted,

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Attachments: